

## **REMARKS**

Claims 32, 35-37, 39-45, and 47-51 are pending in the instant application. Claims 1-31, 33, 38, and 46 were cancelled in previous Amendments. The Applicant disagrees with the Examiner's retraction of allowance of the pending claims and traverses the new obviousness rejections below.

### **Summary of Recent File History:**

The Examiner issued an Office Action on August 20, 2008 wherein claims 1, 5, 7-14, 20-26, 31, and 34 were rejected as obvious over a combination of Tanisaki (U.S. 5,340,618) in view of Kolluri (WO 98/10116). In this same Office Action, the Examiner indicated that claims 32 and 33 were *allowable*. Notably, claim 32 as currently pending is the same as claim 32 that was allowed in this Office Action. Said differently, the Examiner already indicated that claim 32 was allowable over the combination of Tanisaki and Kolluri. Accordingly, in an Amendment filed on November 20, 2008, the Applicant cancelled claims 1, 5-14, 20-26, 31, and 34 and added claims 35-51 to advance prosecution of this application, to accept allowable subject matter, and to accelerate this application to issuance.

In a subsequent Office Action mailed on February 4, 2009, the Examiner again indicated that claim 32 was *allowable* and further indicated that claims 35, 40-43, and 48-51 were also allowable. The other intervening claims (36-39, and 44-47) were rejected under 35 U.S.C. §112. The Applicant remedied the §112 rejections and accepted the allowed subject matter in an Amendment filed on April 6, 2009.

### **Claim Rejections Under 35 U.S.C. §103:**

In the instant Office Action, the Examiner has withdrawn the repeated allowance of the pending claims and has added additional references to the combination of Tanisaki and Kolluri to reject the claims as obvious. More specifically, claims 32, 35-37, 44, and 45 now stand rejected as

obvious over Tanisaki (U.S. 5,340,618) in view of Kolluri (WO 98/10116) and Lickfield (U.S. 5,484,645). Claims 40, 41, 48, and 49 now stand rejected as obvious over Tanisaki in view of Kolluri and Lickfield and also in view of Roth (U.S. 5,414,324). Claims 39, 42, 43, 47, 50, and 51 now stand rejected as obvious over Tanisaki in view of Kolluri, Lickfield, and Roth and also in view of Rickerby (U.S. 6,176,982).

It is important to note that the Examiner has already concluded on the record that independent claim 32 is patentable over the combination of Tanisaki and Kolluri. Thus, the Examiner is clearly relying on Lickfield to teach a limitation that both Tanisaki and Kolluri lack. As set forth on Page 4 of the Office Action, the Examiner is relying on Lickfield to teach “a process where nonwoven fabrics of a first and second nonwoven web has a powdered layer sandwiched between and [a] barrier layer formed onto (column 2, lines 56-column 3, lines 11-18.” The Examiner is directing this teaching towards the last limitation of independent claim 32, i.e., towards carrying a powdered substrate on a reel to reel web support comprising two layers of a non-woven fabric material between which, in use, the powdered substrate is sandwiched.

The Applicant respectfully disagrees with the Examiner regarding both the teachings of Lickfield and the combination of Lickfield with Tanisaki and Kolluri.

**Disclosure, Teachings, and Suggestions of Lickfield (U.S. 5,484,645):**

The Applicant respectfully submits that Lickfield does not whatsoever disclose, teach, or suggest first and second nonwoven webs having a powdered substrate sandwiched therebetween. Instead, Lickfield teaches formation of a composite nonwoven fabric including first and second nonwoven webs and a third web of thermoplastic meltblown microfibers sandwiched

therebetween. It is quite clear that microfibers are not, nor are they analogous to, powdered substrates and cannot be equated thereto.

Moreover, the paragraphs themselves that are cited by the Examiner (i.e., column 2, lines 56-column 3, lines 11-18 of Lickfield) quite clearly explain that the third web of *fibers* is sandwiched between the first and second webs and that these three webs are then fused together (see also Col. 6, Lines 6-16). This fusion of the three webs does not involve any powdered substrate whatsoever. Accordingly, Lickfield does not remedy the deficiencies of Tanisaki and Kolluri. This means that the pending claims are (as they have been since the Office Action of August 20, 2008) both novel and non-obvious and are therefore allowable.

**Inappropriate Combination of Tanisaki, Kolluri, and Lickfield:**

For the sake of argument, even if one were to conclude that Lickfield teaches a powdered substrate sandwiched between two non-woven webs, this reference still cannot be appropriately combined with either Tanisaki or Kolluri to render the invention obvious. Quite simply, Lickfield is non-analogous art to both Tanisaki and Kolluri and would not predictably be combined with either one of these references.

For the Examiner to properly rely on a reference to reject claims as obvious, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." (See *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). As set forth in MPEP §2141.01(a), a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his invention as a whole. Moreover, as explained by the *KSR*

Court, an invention is not obvious unless it simply represents the predictable use of prior art elements.

In this case, the method of fusing the three webs in Lickfield is entirely inconsistent with the methods of treating powders in both Tanisaki and in the instant invention. The fusion of the three webs does not allow any powders to be treated with a monomer and subsequently removed from a plasma reactor, as in both Tanisaki and this invention. This means that Lickfield does not teach any sort of similar process as in Tanisaki or this invention and thus it would not be at all obvious or predictable to look to Lickfield when forming this invention. More specifically, the significant differences in methods evidence that Lickfield is not in the field of the Applicant's endeavor and is not even reasonably pertinent to the particular problem with which the inventor was concerned. Said differently, fusing three webs together does not present the same problems as treating powdered substrates. In addition, the significant differences in methods also evidence that Lickfield is not reasonably pertinent to Tanisaki, would not have logically commended itself to the inventors' attention when forming the instant invention, and certainly does not represent any sort of predictable use of prior art elements.

Moreover, Lickfield does not disclose, teach, or suggest use of a plasma whatsoever. This lack of teaching makes it quite clear that Lickfield is not in the field of the Applicant's endeavor, is not concerned with the particular problem of treating powdered substrates with a plasma, and further evidences why Lickfield is non-analogous to Tanisaki and the instant invention. In fact, because Lickfield does not utilize a plasma, the Applicant questions why any one of skill in the art would predictably look to Lickfield to form the instant invention.

To go even further, the Applicant points out that Lickfield focuses entirely on the formation of fabrics, hospital gowns, and the like that can withstand sterilizing gamma radiation.

As is well recognized in the art, sterilizing gamma radiation is not the same as, or even similar to, a plasma. Similarly, hospital gowns are not even remotely similar to powdered substrates. Just as above, since Lickfield focuses on using entirely different technology than both Tanisaki and the instant invention, the Applicant questions why any one of skill in the art would predictably look to Lickfield to form the instant invention. The Applicant respectfully submits that one of skill in the art would not look to Lickfield at all.

**The Examiner's Rationale For Combining References:**

The Applicant is confused as to the Examiner's statement in the second full paragraph on Page 4 of the Office Action. In this paragraph, the Examiner asserts that it would have been obvious to modify the process of "Goodwin" (i.e., the instant application) to include the teachings of Lickfield, Tanisaki, and Kolluri. The Applicant respectfully submits that such an assertion is not based in the law and improperly relies on hindsight and using the Applicant's own work as a roadmap to interpret the prior art. Such ex-post reasoning was explicitly forbidden by the Supreme Court in *KSR*.<sup>1</sup> Moreover, the legal standard for assessing obviousness is clearly set forth in §103 and is based on the prior art alone and not on any sort of modification of the invention itself. To the Applicant's knowledge, no where in the settled law is it permitted for an Examiner to use the Applicant's own invention in a combination with the prior art.

**Conclusion:**

The Applicant respectfully submits that Lickfield does not disclose, teach, or suggest first and second nonwoven webs having a powdered substrate sandwiched therebetween. Since each of the Examiner's rejections relies, at least in part, on the teachings of Lickfield, then each

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<sup>1</sup> The Court cautioned that factfinders must be aware of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.

rejection is deficient and must be withdrawn. All pending claims are thus allowable and the Applicant requests such allowance. This Response is being filed timely, thus, it is believed that no fees are presently due. The Commissioner is authorized to charge any fees or credit any overpayment to Deposit Account No. 08-2789, in the name of Howard & Howard Attorneys PLLC.

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS PLLC**

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Date

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